REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed 07/13/2005. Consideration and allowance of the application and presently pending claims as amended, is respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, the following amended and new claims will be pending:

Original claims: **1, 4-6, 9 and 10**
Amended claims: **1 and 10**
Cancelled claims: **none**
New claims: **11**

Claims 2, 3, 7 and 8 have previously been cancelled. New independent claim 11 has been added. The amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application and place the claims in condition for allowance.

2. Rejection of claims 1-3 and 5-8 under 35 U.S.C. §103

Claims **1-3 and 5-8** have been rejected as being unpatentable over Tsai (USP 6582235) in view of Ochi (USP 5315911). Applicants would note that claims 2, 3, 7 and 8 have previously been cancelled from the application. Claims 1, 4, 5 and 6 remain in the present application.

The office action acknowledges that Tsai does not teach the displaying of lyrics contained in the memory unit in a predetermined synchronization with actuation of the keyboard. The office action asserts that *Ochi discloses a music score display device which comprises the displaying of lyrics contained in the memory unit in a predetermined synchronization with actuation of the keyboard (Fig. 3).* Further, the office action asserts that it would have been obvious to one of ordinary skill in the art to

adapt the teachings of Tsai *et al* with those of Ochi, "*so as to allow for more automatic display of the user data*".

Applicants disagree with the assertions of the office action and respectfully submit that the office action herein does not establish a case of prima facie obviousness with regard to claims **1, 4, 5 and 6**. Further, with respect to the stated basis that the claimed invention is obvious, Applicants would point out that it is simply unclear and unknown just what is meant by the supposed motivation to combine of "*more automatic display of user data"* as set out in the office action. The invention(s) of claims **1, 4, 5 and 6** clearly do not specify or require "more automatic display of user data". Applicants submit that one skilled in the art would not be motivated in this way, but even if they were, such a vague and obscure motivation would NOT lead them to the cited art and a decision to combine/modify them so as to arrive at the present claimed invention.

Applicants note that Tsai is directed to a method and apparatus for displaying music piece data such as lyrics and chord data, while Ochi is directed to a music score display device. Tsai states that it is an object to provide "an improved music-piece-data display controlling method and apparatus which displays lyrics or chord progression on a predetermined display screen in an easy-two-read fashion" and "a music-piece-data display controlling method and apparatus which allows a user to readily perform a musical instrument manually to progression of an automatic performance of a music piece by displaying individual performance timing for playing the musical instrument and tone pitches to be performed on the musical instrument in accordance with a performance progression of a music piece" (see column 2, lines 23 – 33). Ochi discloses that it is an object of the invention to provide a music score display device that is capable of displaying always correct music score according to the actual playing.

Applicants note that the office action does not provide any details on how the devices of Tsai and Ochi could/would be combined/modified without impairing or otherwise destroying the functionality of each separate device function. Even if such modification/combination could arguably be successfully made, the mere fact that the

prior art can be modified so as to (arguably) result in the combination defined by the claims at issue does not make the modification obvious unless the prior art suggests the desirability of such modification. As mentioned above, the purported motivation of "*more automatic display of user data*" is not clear and not understood by applicant. Nonetheless, the references cited by the Office Action herein do not suggest or otherwise teach the desirability of the present claimed invention, nor do they suggest or teach more automatic display of user data. There is simply no motivation, teaching or suggest of the claimed invention found anywhere in the prior art.

It is completely improper to use the present claimed invention as a guide through the maze of prior art references in order to combine references in just the right way so as to achieve the results of the claims at issue. The present invention has been used as a road map for attempting to purporting modification/combination of Tsai and Ochi to somehow achieve a device that purportedly would include attributes of the present claimed invention.

3. Rejection of claims 4, 9 and 10 35 U.S.C. §103

Claims **4, 9 and 10** have been rejected as being unpatentable over Tsai (USP 6582235) in view of Ochi (USP 5315911), and further in view of Akimoto et al. Without repeating here, all comments, concerns and arguments made above in connection with the rejection of claims 1-3 and 5-8 are equally applicable to the rejection of claims 4, 9 and 10 and thus made. In addition, applicants would note that the shear volume of references that the office action has now tried to bring together to support the rejection of these claims under 35 U.S.C. §103 speaks substantial volumes about just how unobvious such a combination/modification really is. It is respectfully submitted that the proposed combination of Tsai, Ochi and Akimoto is simply not suggested or taught by the prior art. Reconsideration of these claims in view of the amendments herein is now requested.

In the interests of advancing prosecution of the present application, claims 1 and 10 have been amended and new claim 11 has been added. Claim 1 has been

amended to specify and require, among other things, *recorder for recording vocal input for subsequent playback in synchronization with said lyrics when said musical instrument is placed into an auto performance mode. Further claim 10 has been amended , and new claim 11 added, both specify and require, among other things,* recorder for recording vocal input received from the microphone for playback during a performance mode.

Reconsideration and allowance of claims 1 and 10, and dependent claims 2-3, 4as amended herein, is requested. With respect to dependent claims 2-3 and 5-8, reconsideration of these claims in view of the amendment herein is requested.

Further, each and every limitation of the claim at issue must be considered. In the case of dependent claims, such as claims 3 this requires that each and every limitation of the independent claim (claim 2) and any intervening claims, from which they depend also be considered.

4. Amended Claims

Claim 1 has been amended to specify, among other things, a musical instrument that incorporates a recorder for recording vocal input for subsequent playback in synchronization with said lyrics when said musical instrument is placed into an auto performance mode. This claim as well as dependent claims 4 - 6 and 9 are believed to meet all requirements for allowance.

Claim 10 has been amended to specify, among other things, a musical instrument that incorporates a recorder for recording vocal input received from the microphone for playback during a performance mode.

5. Acknowledgement

Applicant acknowledges the prior art made of record.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims **1, 4-6, 9 and 10,** as well as new **claim 11,** are in condition for allowance. Favorable re-consideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (678) 352-0103.

Certificate of Mailing

I hereby certify that this correspondence, and attachments, if any, is being deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

DATE: **December 12, 2005**

Robert P. Biddle (Reg# 35, 826)

6300 Powers Ferry Road
Suite 600-183
Atlanta, GA 30339

TEL: 678-352-0103
FAX: 404-795-0870

Respectfully submitted,

Biddle & Associates, P.C.

By: _____

Robert P. Biddle

(Reg # 35, 826)